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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948

—  
No. 183 '  
—

REMINGTON RAND INC.,

*Petitioner,*

*vs.*

ROYAL TYPEWRITER COMPANY, INC.,

*Respondent.*

—  
**PETITION FOR WRIT OF CERTIORARI TO THE  
CIRCUIT COURT OF APPEALS FOR THE SECOND  
CIRCUIT AND SUPPORTING BRIEF**  
—

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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948

REMINGTON RAND INC.,  
*Petitioner,*

*vs.*

ROYAL TYPEWRITER COMPANY, INC.,  
*Respondent.*

No.

**PETITION FOR WRIT OF CERTIORARI TO  
THE CIRCUIT COURT OF APPEALS FOR THE  
SECOND CIRCUIT**

TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSO-  
CIATE JUSTICES OF THE SUPREME COURT OF THE  
UNITED STATES:

Your Petitioner, Remington Rand Inc., respectfully  
prays for a Writ of Certiorari to the United States Circuit  
Court of Appeals for the Second Circuit to review a judg-  
ment of that Court entered on May 21, 1948.

A certified transcript of the record, including the pro-  
ceedings in said Circuit Court of Appeals, is furnished  
herewith, pursuant to Rule 38 of the rules of this Court.

**Summary Statement of the Matter Involved**

The present action was brought by Royal Typewriter  
Company, Inc. against Remington Rand Inc., petitioner  
here, for alleged infringement of the Woodfine patent No.

1,916,905, issued July 4, 1933, for "Margin Regulator for Typewriters" (R. 69).

Both courts below held this patent infringed by petitioner's standard typewriters and granted an injunction (R. 249, 261). As is fully shown hereinafter, pages 8, 14, the manufacture of typewriters is concentrated in the Second Circuit; all manufacturers of such machines are subject to suit in the Second Circuit; and there is no likelihood that the validity or scope of the Woodfine patent will be passed upon in any other Circuit.

Petitioner's answer denied infringement (R. 5, par. 4) and also alleged that the Woodfine patent was invalid for lack of invention in view of prior patents (R. 6, par. 7). At the trial and on appeal, petitioner did not rely upon the defense of invalidity,\* but upon the defense of non-infringement in view of the fact that the claims of the patent, for combinations of old elements, contain express limitations clearly excluding petitioner's machines.

The facts in the case are simple and, as such, are not in dispute. The testimony occupies less than 60 pages of the record. The only issue is as to the proper rule of law applicable to the uncontested facts.

Both courts below recognized that the Woodfine patent was merely an improvement and not a pioneer patent, the

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\*The Court has the power to consider validity on its own motion, and, if of the opinion that the patent is invalid, should in the public interest so hold. *Hill v. Wooster*, 132 U. S. 693, 698; *Magic v. Smith*, 38 F. 2d 170, 173, 10 Cir.; affirmed 282 U. S. 784, 792. See also in this connection the discussion of the Court of Appeals in the present case and its reference to the statement of this Court in *Sinclair Co. v. Interchemical Corp.*, 325 U. S. 327, 330, that it is usually the better practice to inquire fully into validity (R. 256).

District Court stating "this is an improvement patent" (R. 242), and the Court of Appeals stating that "Woodfine's was not a major achievement;" and "its contrivance did not demand a high flight of inventive genius," (R. 258).

Both courts also recognized that the claims of the patent do not read on petitioner's device, the District Court saying that "Admittedly the claims do not read literally on the alleged infringing device," (R. 236), and the Court of Appeals that "defendant's 'margin regulator' does not verbally correspond throughout with the claims in suit," (R. 257). Nevertheless, both courts found infringement by resorting to the so-called "doctrine of equivalents" to give the patent broader coverage than was called for by the unambiguous terms of its claims.

In so deciding, the Court of Appeals declared that a patent "is peculiar in this, that after all aids to interpretation have been exhausted, and the scope of the claims has been enlarged as far as the words can be stretched, on proper occasions *courts make them cover more than their meaning will bear.*"\* (R. 257).

Petitioner's position is that the courts below clearly erred in applying any such doctrine in this case and that the doctrine applied is an extremely dangerous one which, unless carefully circumscribed by this Court, will work great detriment to the public, which must rely upon the claims of a patent to determine what it is and is not free to do.

The Court of Appeals itself characterized the doctrine as "strictly speaking, an anomaly;" (R. 257), and in discussing this Court's recent decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, referred to "the anti-mony inherent in the whole doctrine." and concluded with

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\*Emphasis ours throughout.

the statement that maybe the doctrine "will disappear, but nothing so far satisfies us that as yet it has" (R. 261).

The Woodfine patent is merely a minor improvement patent for a combination of old elements as stated, and further than that it is only a paper patent that no one, not even the respondent itself, has ever used (*infra*, p. 28). This lack of use of the patent by anyone was completely ignored by the Circuit Court of Appeals.

When the application for the Woodfine patent was filed it contained a broad claim (R. 204-5) which would have read on petitioner's device. This broad claim was rejected by the Examiner (R. 214) and then cancelled by Woodfine, who accepted the narrow claims here in issue. At the same time that he cancelled this broad claim, Woodfine also cancelled from the specification (R. 215) a statement that "various changes as to the shape, size and arrangement of parts" could be made without departing from his invention or the scope of his claims (R. 204, Fol. 612).

Normally, each typewriter has two margin stops, which are adjustably mounted for movement along a rack bar carried by the typewriter carriage. The margin stops determine the location of the right- and left-hand margins of any matter that is being typed, by coming into abutment with a fixed center post carried by the typewriter frame. Each margin stop carries a releasable catch to hold the stop in place on the toothed rack bar, except when released by being raised above the teeth so that the stop can slide along the rack to change the margin.

The construction shown and claimed in the Woodfine patent, without going into detail, consists of a pair of trip bars mounted on the carriage, with a key rigidly attached to the end of each trip bar at opposite ends of the carriage,

so as to depress each trip bar when its respective key is depressed. A cord tensioned by a spring is attached to the catches on the two margin stops, so as normally to hold the catches in place between the teeth on the rack bar, and so as to draw the two margin stops toward each other until they hit the center post, whenever the catches are released. The release of a catch is effected by pressing down the key on the applicable trip bar, that trip bar in turn pressing down on one end of the catch to release the opposite end from the rack and allow the margin stop to be pulled along the rack to the center post by the spring tensioned cord.

The District Court found that "Margin stops were old in the art;" (R. 241) and that "Springs were used in prior patents to bring the stops back to their last previous setting when they had been temporarily released to allow writing in the previously-used margin" (R. 235). Moreover, as respondent admitted in its brief in the Court of Appeals (p. 7) "it was a very common expedient to operate movable elements in the interior of a typewriter machine by a key on the keyboard through a connection consisting of a series of links and levers."

As appears from the opinion of the District Court in the companion case of *Royal Typewriter Co. v. L. C. Smith & Corona Typewriters, Inc.*; 76 F. Supp. 190, 192-3,—decided the same day as the present case and in which that defendant's machine was also held to infringe although outside the patent claims\*—respondent picked the Woodfine patent up "*at a bargain*" for a "relatively nominal purchase price", while respondent was in the course of development of its own, different device which it shortly

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\*Defendant in that case waived an appeal from the interlocutory judgment of infringement, pending an accounting and the decision on appeal in the present case.



thereafter put on the market. Respondent made this purchase for \$10,000 in 1937 (FF 3, 4, R. 243), four years after the patent issued. The following year, 1938, respondent put on the market its typewriter with so-called "Magic Margin Control" (R. 14) which in some respects resembled the device disclosed in the Woodfine patent, but departed from it to such an extent that it was not covered by any of the claims of the patent (R. 23-4, 46). It was like Woodfine, however, in having the operating keys located on the carriage, with each key firmly attached to its respective trip bar, one trip bar being depressed to release the catch on one margin stop and the other trip bar being depressed to release the catch on the other margin stop.

L. C. Smith placed its typewriters with margin control on the market in October 1939. Respondent had knowledge of these machines prior to December 1940, but did not notify L. C. Smith of infringement or bring suit until March 1947, at which time respondent filed separate suits against both L. C. Smith and petitioner in the same District Court. In its memorandum decision on the decree in this *L. C. Smith* case, the District Court specially found that:

"The plaintiff [respondent] has not merely acquiesced in defendant's [L. C. Smith's] infringement over a long period. It has led defendant by its assurances, based on opinions of plaintiff's then patent counsel that defendant's device did not infringe, to continue to emphasize the value of the device in advertising its machine for sale in competition with the plaintiff and others."

Respondent thus withheld suit against L. C. Smith for more than seven years during which L. C. Smith had on the market a machine which accomplished the same result as petitioner's and respondent's own machines. And it





## DEFENDANT'S EXHIBIT 5

### Claim 2 of Woodfine Patent in Suit No. 1,916,905

1. A movable carriage and
2. a fixed stop post, of
3. a rack bar mounted on the carriage,
4. a pair of stops disposed for longitudinal sliding movement on the rack bar,
5. an oscillatory catch member mounted on each stop,
6. means attached to the stops adapted to
  - a) releasably adjust the catch members to a stop securing position and
  - b) tending to slide the stops in opposite directions on the rack bar,
7. *a pair of oscillatory trip bars engageable with the catch members,*
8. *means normally retaining the trip bars in elevated non-tripping position, and*
9. *keys attached to each trip bar and extending therefrom whereby the trip bars may be actuated to a stop releasing position from a remote operating position.*

was during this period that petitioner's machine with its so-called "Keyboard Margin Control" was developed (R. 31) and placed on the market in June 1946 (FF 5, R. 243).

Prior to its introduction on the market, petitioner's machine was submitted to its patent attorney, who rendered an opinion that it clearly did not infringe the Woodfine patent, because of express limitations in the patent claims (R. 33-6, 222). Accordingly, the manufacture and sale of petitioner's device was undertaken in reliance upon these limitations in the claims.

As an illustration of the limitations in the claims, we have reproduced opposite this page petitioner's Exhibit 5 (R. 230) in which claim 2 of the Woodfine patent held to be infringed is broken down into separate elements. The express limitations to which petitioner's machines do not respond are printed in italics so they may be readily noted.

While the ultimate result accomplished in petitioner's device resembles that accomplished by the Woodfine patent in that each provides for a form of remote control of the margin stops, assisted by different arrangements of springs, there is a basic difference in approach and a variety of differences in construction which make petitioner's device fundamentally different from and superior to Woodfine both in construction and mode of operation. This basic difference stems from petitioner's provision of *keyboard* margin control rather than *carriage* margin control, as in Woodfine.

Woodfine has two normally elevated downwardly movable trip bars, one for releasing each of his margin stop detents. His trip bars are entirely distinct from each other and each has rigidly fixed thereto an operating key carried at opposite ends of the carriage. Petitioner has a single trip bar which has a normally neutral position and is movable upwardly to release the detent of the right-hand margin stop,

and downwardly to release the detent of the left-hand margin stop. Petitioner's device has a pair of operating keys on the keyboard which are carried by the fixed frame structure of the machine. Since its single trip bar moves to and fro with the carriage, the operating keys cannot be fixed or "attached" to the trip bar. The trip bar has free and independent movement relative to the operating keys in the direction of movement of the carriage, and the bar elevating and lowering means of the machine frame engages the carriage-mounted bar only during actual margin setting. Petitioner's construction would be inoperative if the keys were in any way attached to the trip bar, as shown in the Woodfine patent and called for in the patent claims.

The judgment of infringement in this case leaves the petitioner at a serious competitive disadvantage, not alone because it must change the construction of a large part of its typewriter manufacture at a time when typewriters are still in very short supply,\* but because the loose application of the doctrine of equivalents by the Circuit Court of Appeals leaves petitioner practically powerless to determine what it can and what it cannot make without being cited for contempt.

As appears from the annexed affidavit of Howard V. Widdoes, Vice President in charge of petitioner's typewriter division (Appendix, p. 31), all typewriters made in the United States are subject to suit in the Second Circuit. This is because more than 95% of all typewriters are actually manufactured in the Second Circuit, and the only typewriter manufacturer whose typewriters are manufactured elsewhere, has a regular and established place of business in New York City at which its typewriters are sold, and has filed a certificate of doing business in the State of New York and is qualified to do business

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\*And see F.F. 16 (R. 246).

there. The Widdoes affidavit further shows that approximately 66% of all standard typewriters manufactured include a remote margin control, and have an annual retail sales value of more than \$70,000,000. All such typewriters now being manufactured are made by the Royal Typewriter Company, Inc., the patent owner and respondent in this case; Remington Rand Inc., the defendant and petitioner in the present case; and L. C. Smith & Corona Typewriters, Inc., the defendant in the companion case. Thus, the patent here in suit dominates a very large and important part of the typewriter industry so concentrated in the Second Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely.

### **Jurisdiction**

1. This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24 (7) (28 U. S. C. Sec. 41 (7)).

2. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended, (28 U. S. C. 347) and Rule 38 (5) (b) of the rules of this Court.

3. The date of the judgment which petitioner seeks to have reviewed is May 21, 1948 (R. 261).

### **Questions Presented**

1. Is the public entitled to rely upon the claims of a patent as defining the limits of the patentee's monopoly, or may a court ignore clear limitations in the claims to find infringement by a device outside the claims, manufactured by one who has relied upon such limitations?

2. Where the art involved is a crowded one and a court recognizes that the patent in suit is not a pioneer but only a minor improvement, and where the patentee cancelled from his application a broader claim which would have covered defendant's device and at the same time struck from the specification a statement that various changes as to size, shape and arrangement of parts could be made without departing from his invention or the scope of his claims, may a court properly resort to the doctrine of equivalents to pass over clear structural limitations of the claims of the patent and find infringement by a device fundamentally different from and superior to that shown in the patent and covered by the patent claims?

3. If the patent in suit is a mere "paper" patent which has not been followed even by the patent owner, is the patent owner nevertheless entitled to a monopoly extending beyond the clear terms of the patent claims, or is such a patent to be strictly interpreted in favor of the public?

#### **Reasons Relied Upon for the Allowance of the Writ**

1. The concentration of typewriter manufacture in the Second Circuit, which has in this case given the patent in suit an extremely broad interpretation, makes it highly improbable that the courts of any other circuit will have an opportunity to pass upon either the validity or scope of this patent. In such circumstances this Court has recognized the desirability of granting certiorari despite the lack of conflict of decision as to the particular patent involved. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Altoona Publix Theatres, Inc. v. American*

*Tri-Ergon Corp.*, 294 U. S. 477; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, 50; *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 128; *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co.*, 315 U. S. 759; *Mackay Radio & Telegraph Co. v. Radio Corporation*, 306 U. S. 86, 89.

2. In applying the doctrine of equivalents in this case to find infringement of a paper patent for a minor improvement in a crowded art by a superior device which departs substantially from the terms of the claims, the Circuit Court of Appeals decided an important question of patent law in a way which conflicts with many decisions of this Court holding that the claims are the limit of the patentee's monopoly and that "the limits of the patent are narrowly and strictly confined to the precise terms of the grant", *Mercoid Co. v. Mid-Continent Co.*, 320 U. S. 661, 665; *McClain v. Ortmyer*, 141 U. S. 419; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 278. In view of the importance to the public of preventing undue extension of the patent monopoly, this Court has granted certiorari in many recent cases to correct mis-application of important points of patent law despite the lack of conflict of decisions as to the particular patent involved. *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, 3; *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U. S. 661, 663; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211; *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U. S. 488; *Sola Electric Co. v. Jefferson Electric Co.*, 317 U. S. 173.

**Prayer**

Wherefore your petitioner respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Second Circuit be reversed, and that petitioner be granted such other and further relief as may be just.

Respectfully submitted,

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**BRIEF IN SUPPORT OF PETITION****Opinions of the Courts Below**

The opinion of the United States District Court for the District of Connecticut was filed October 3, 1947 (R. 232) and is reported at 76 Fed. Supp. 220.

The opinion of the Circuit Court of Appeals for the Second Circuit was filed May 21, 1948 (R. 256).\*

**Jurisdiction**

The jurisdictional statement appears in the accompanying petition.

**Statement of the Case**

The essential facts are stated in the accompanying petition.

**Specification of Errors**

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In applying the doctrine of equivalents in this case to find infringement of a patent for a minor improvement in a crowded art by a device which substantially departs from the terms of the patent claims, manufactured by one who relied upon the clear limitations in the claims.

2. In applying the doctrine of equivalents in this case to find infringement by a device fundamentally different from and superior to that described and claimed in the

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\*Not as yet reported in the Federal Reporter System.

patent, despite the fact that the patentee had cancelled from his application a broader claim which would have covered defendant's device and cancelled from the specification a statement that "various changes as to the shape, size and arrangement of parts" could be made without departing from his invention or the scope of his claims.

3. In finding infringement in this case by granting to the patent a broad range of equivalents outside the patent claims, despite the fact that neither the plaintiff patent owner itself nor anyone else ever manufactured or sold the device described and claimed in the patent.

4. In affirming the judgment of the District Court and in not reversing that judgment.

### **Summary of Argument**

The points of the argument follow the reasons assigned for the allowance of the writ.

### **Argument**

**THE CONCENTRATION OF THE TYPEWRITER INDUSTRY IN THE SECOND CIRCUIT MAKES IT HIGHLY IMPROBABLE THAT THE WOODFINE PATENT WILL BE LITIGATED ELSEWHERE AND IMPORTANT THAT THIS COURT SHOULD CONSIDER THE MONOPOLY GRANTED TO THAT PATENT BY THE DECISION OF THE COURT BELOW.**

As pointed out in the petition, *supra* p. 8, and in the affidavit of Howard V. Widdoes (Appendix, p. 31), more than 95% of all typewriters manufactured in the United States

are manufactured within the Second Circuit. The only typewriter manufacturer in this country which does not manufacture within the Second Judicial Circuit is subject to suit in that circuit because it has a regular and established place of business there where it sells and delivers typewriters. Now that the Court of Appeals for the Second Circuit has given such a broad construction to the Woodfine patent, it is obviously unlikely that the patent owner, a New York corporation, will bring suit in any other circuit.

In granting certiorari in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, (1938) this Court said that the petition for rehearing showed that:

" \* \* \* litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit. Cf. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477" (p. 50).

And in *Muncie Gear Works v. Outboard Marine & Mfg. Co.*, 315 U. S. 759, 765-6, (1942) this Court said:

"While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. 314 U. S. 594. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47."\*

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\*To the same effect are *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 128; *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co.*, 315 U. S. 759; and *Mackay Radio & Telegraph Co. v. Radio Corporation*, 306 U. S. 86, 89.

**IN APPLYING THE DOCTRINE OF EQUIVALENTS IN THIS CASE TO FIND INFRINGEMENT OF A PAPER PATENT FOR A MINOR IMPROVEMENT IN A CROWDED ART BY A SUPERIOR DEVICE WHICH DEPARTS SUBSTANTIALLY FROM THE TERMS OF THE CLAIMS, THE CIRCUIT COURT OF APPEALS DECIDED AN IMPORTANT QUESTION OF PATENT LAW IN A WAY WHICH CONFLICTS WITH MANY DECISIONS OF THIS COURT. THIS CONFLICT SHOULD BE RESOLVED BY A DECISION OF THIS COURT.**

**The use of the doctrine of equivalents to expand the patent monopoly beyond the terms of the claims is an anomaly and should be strictly limited.**

Petitioner does not seek a review of the facts, which are not in dispute. The question presented is as to the proper rule of law applicable to the uncontested facts.

The rule of law involved is the so-called "doctrine of equivalents", a name sometimes applied by the courts to two quite different things. Perhaps the most common use of the term arises from the well established rule that even though the claims of a patent may be literally infringed, the courts will not find infringement unless the defendant has appropriated the substance of the patentee's invention or, to put it differently, there can be no infringement unless what the defendant has done is "an equivalent" of what the patent shows and describes. As to the propriety of this rule, there can be no question, and it is not involved here.

However, the term "doctrine of equivalents" has also been applied in a considerable number of cases, chiefly during an era when patents were treated with great liberality, to sustain a holding of infringement despite the fact that the defendant had not done anything within the terms of the patent claims. This doctrine arose at a time when most patent claims were very inexplicit and were for the device

"substantially as shown and described," with the result that a court, in considering the patent, had to determine the scope of the invention in view of the prior art without much assistance from the claims.

Apparently the use of the doctrine of equivalents to hold infringement outside the terms of the claims originated in *Winans v. Denmead*, 15 How. 330 (1853). The Court in that case, in a five to four decision, held that a claim calling for a coal car "in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions \* \* \*" was infringed by a car which was octagonal rather than circular in outline. Chief Justice Taney was one of the four dissenters, Justice Campbell stating in the dissenting opinion:

"\* \* \* Fullness, clearness, exactness, preciseness, and particularity, in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfil the demands of congress or the wants of the country. Nothing, in the administration of this law, will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of congress. In my judgment, the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import." (p. 347)

Subsequent to *Winans v. Denmead*, the doctrine of extreme liberality in determining the scope of patent claims was followed in a number of cases, including some cases in this Court. However, this Court, during most of the long period since that decision, has held firmly to the basic

rule that the claims establish the limit of the patentee's monopoly and that the public is entitled to rely on the terms of the claims to determine what may be done without infringing the patent. Perhaps the classic statement of this basic rule was in the opinion of Mr. Justice Bradley in *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 278 (1877):

"\* \* \* When a claim is so explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. Since the act of 1836, the patent laws require that an applicant for a patent shall not only, by a specification in writing, fully explain his invention, but that he 'shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to. If the office refuses to allow him all that he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear

and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. *Merrill v. Yeomans*, 94 U. S. 568. He can claim nothing beyond it."

Other leading statements of the rule are:

*White v. Dunbar*, 119 U. S. 47, 51-52 (1886):

"Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

*McClain v. Ortmyer*, 141 U. S. 419, 423-424 (1891):

"\* \* \* While the patentee may have been unfortunate in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, we are not at liberty, without running counter to the entire current of authority in this court, to construe such claims to include more than their language fairly imports. Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the pub-



lic. The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them. The **claim** is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it."

*Permutit Co. v. Graver Corp.*, 284 U. S. 52, 60 (1931):

"\* \* \* The statute requires the patentee \* \* \* to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not."

*Milcor Steel Co. v. Fuller Co.*, 316 U. S. 143, 145-6 (1942):

"\* \* \* it is these claims, not the specifications, that afford the measure of the grant to the patentee. 'Out of all the possible permutations of elements which can be made from the specifications, he reserves for himself only those contained in the claims.' 122 F. 2d 292, 294."

*Mercoid Corp. v. Mid-Continent Co.*, 320 U. S. 661, 665 (1944):

"\* \* \* the limits of the patent are narrowly and strictly confined to the precise terms of the grant. \* \* \* It is the protection of the public in a system of free enterprise which alike nullifies a patent where any part of it is invalid (*Marconi Wireless Co. v. United States*, 320 U. S. 1, 58; and see *Gen-*



*eral Electric Co. v. Wabash Corp.*, 304 U. S. 364, 372) and denies to the patentee after issuance the power to use it in such a way as to acquire a monopoly which is not plainly within the terms of the grant."

*Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, 3 (1946):

"This statutory requirement of distinctness and certainty in claims is important in patent law."

The conflict between the use of the doctrine of equivalents to expand the monopoly of a patent beyond the terms of its claims and the basic rule that the claim measures the scope of the monopoly, has been pointed out a number of times. One such statement is in the opinion of the court below in *Claude Neon Lights v. E. Machlett & Son*, 36 F. 2d 574, 575-6, written by the same judge who wrote the opinion in the present case:

"\* \* \* The doctrine of equivalents, though well settled for many years, is anomalous, if the claim is measured only by its words, and for this reason we once went so far as to say that it means no more than that the language of claims shall be generously construed. *Motion Pictures Co. v. Independent Co.*, 200 F. 411 (C. C. A. 2). Such a limitation is however irreconcilable with those extremely numerous decisions which have extended a claim to structures which by no possibility it could cover, judged by any tenable canons of documentary interpretation.

\* \* \* In *Winans v. Denmead*, 15 How. 343, 14 L. Ed. 717 (1853), the Supreme Court, apparently for the first time, laid down the doctrine over a strong dissent, and based it upon the theory that the claim was not intended to be verbally definitive, but to

cover the 'invention' which should, to some extent anyway, be gathered from the disclosure at large.

"It is plain that such latitude violates in theory **the underlying and necessary principle** that the disclosure is open to the public save as the claim forbids, and that it is the claim and that alone which measures the monopoly. \* \* \* The vacillation in the decisions is a necessary consequence of this inconsistency in theory, somewhat analogous to the similar inconsistency which pervades reissues and amendments. It is the claim which singles out from the complex disclosed those elements which constitute the 'invention,' and substantially the whole work of the Patent Office lies in determining, not whether the disclosure is new because all of it never is, but whether the claims proposed are. Strictly the disclosure should **be used** therefore only as the setting of the claims and to find what the words employed really mean. Otherwise courts would have to assume the duties of the office afresh and compose such claims as the prior art might have allowed, had the patentee been foresighted enough to include all possible variants of his meaning. Such a result the decisions have repeatedly repudiated, and it would result in an intolerable burden upon the public, which would be charged not only with a knowledge of the prior art at the time of the application and often earlier, but with a right conclusion as to how much room was left for invention, seldom an easy question."

So far as we can determine, this Court has not extended the monopoly of any patent beyond the terms of the patent claims by use of the so-called doctrine of equivalents since its decision in *Hoyt v. Horne*, 145 U. S. 302 (1892). In *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405 (1908); *Hildreth v. Mastoras*, 257 U. S. 27

(1921), and *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30 (1929), this Court discussed the doctrine of equivalents, but it would appear that the devices held to infringe in those cases were within the literal scope of one or more claims of the patents involved, and the real inquiry was whether the defendants' devices were sufficiently unlike the patented device to escape infringement despite being within the terms of the claims.\*

In the recent case of *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126 (1942), the petitioner did not seriously urge that its device was not the mechanical equivalent of that called for in the patent claims, but argued that the doctrine of equivalents should be discarded as contrary to the demands of the patent statutes that the patent shall "particularly point out and distinctly claim" the invention. (Rev. Stat. § 4888, 35 U. S. C. § 33).\*\* The Court found that it

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\*We think it clear from the description of the infringing devices contained in the opinion in the *Sanitary* case that those devices were within the terms of claim 7 of the *Winters* patent there in suit. Whatever may be the fact as to that case, it was decided in 1929, and we have been unable to find any decision of this Court since that time extending the monopoly of a patent beyond the terms of its claims.

\*\*This Court stated (p. 128):

"We granted certiorari, 314 U. S. 702, on a petition which challenged only the decree of infringement below, *on the ground that it enlarged the scope of the patent as defined by the claim, by resort to the doctrine of equivalents* and that Nelson, the patentee, by the amendment of his claims in the Patent Office, had surrendered Claim 4 so far as it would otherwise read upon the alleged infringing devices. Neither in their petition nor in their brief and argument in this Court have petitioners contended that the patent is invalid for want of invention. Although there is no conflict of decision, we were moved to grant the petition by the nature of the questions presented, together with a showing that the industry affected by the patent is located in the seventh circuit so that litigation in other circuits resulting in a conflict of decision would not be likely to occur."

did not need to pass upon the contention that the doctrine of equivalents was in conflict with the patent statute and with the many decisions of this Court stressing the claim as measuring the invention, stating at page 136:

"We do not find it necessary to resolve these contentions here. Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment."

The Court does not need to reject any reasonable interpretation of the doctrine of equivalents in order to reverse the holding of infringement below. However, we do submit that it would be greatly in the public interest for the Court to consider the present case, expressly reject the broad interpretation of the doctrine of equivalents applied below, and impose the requisite limitations upon the loose application of that doctrine so that the public may be protected by a clear notice in the patent claims as to the limits of the patentee's monopoly.

The paramount public interest is in clearly defining the areas open for experimentation and in clearly informing the public as to what it can do without infringement. This was the policy of Congress in enacting a statute requiring that the patent shall describe and *claim* the invention. Plainly this case presents a question of great importance, namely, whether the public interest requires confining the patent monopoly to the specific wording of claims or whether the owner of a patent which is for a minor improvement in a crowded art shall be permitted to escape the statutory requirement and capture a broader monopoly under a doctrine

loosely applied through the use of uncertain criteria, the effect of which must necessarily be to stifle competition and further improvement.

The court below has attempted to justify its application of the doctrine of equivalents by nebulous criteria, e.g., "a boundary cannot be drawn"; "the draftsman of claims is always in something of a dilemma"; "it is impossible \* \* \* to emerge from the embarrassment without *some measure of compromise*"; "it is always a *question of degree*"; "the allowable latitude in a given instance"; "*Halliburton Oil Well Cementing Co. v. Walker, supra*, did apply the rule \* \* \* with *some severity*; but in the case at bar \* \* \* the *mesne* has been observed"; (all at R. 260); and "the *anti-mony* inherent in the whole doctrine" (R. 261). Yet, in the concluding sentence of its opinion the court expressed its own misgivings as to whether the doctrine will not disappear altogether (R. 261), and, it seems to us, thereby clearly indicated that it would welcome a review by this Court.

If this Court did apply the rule in the *Halliburton case* with some severity, as stated by the court below, we submit that the protection of the public interest was the overriding consideration.

It is submitted that the reasoning of the Circuit Court of Appeals below (R. 259-260) in considering the *Halliburton* case leads to the paradoxical conclusion that claims, to be valid, must be specifically worded to protect the public, but that courts in enforcing those claims against the public may disregard the specific wording. This would give the public protection in form but not in substance.

The writ of certiorari should issue to the court below to the end that inventive genius should not be frightened

from the course of experimentation and to allow any member of the public to manufacture, use and sell anything outside the clear terms of the claims of a patent without fear that a court will later extend the patent beyond the terms of its claims and hold him an infringer.

The broad philosophy of the public interest aspect of the Patent Laws was stated by this Court in *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U. S. 488, where it was said (p. 492):

"The grant to the inventor of the special privilege of a patent monopoly carries out a public policy adopted by the Constitution and laws of the United States, 'to promote the Progress of Science and useful Arts, by securing for limited Times to \* \* \* Inventors the exclusive Right \* \* \*' to their 'new and useful' inventions. United States Constitution, Art. I, § 8, cl. 8; 35 U. S. C. § 31. But the public policy which includes inventions within the granted monopoly excludes from it all that is not embraced in the invention. It equally forbids the use of the patent to secure an exclusive right or limited monopoly not granted by the Patent Office and which it is contrary to public policy to grant."

and again in *Mercoide Corporation v. Mid-Continent Investment Co.*, 320 U. S. 661, 665:

"The grant of a patent is the grant of a special privilege 'to promote the Progress of Science and useful Arts.' Const., Art. I, § 8. It carries, of course, a right to be free from competition in the practice of the invention. *But the limits of the patent are narrowly and strictly confined to the precise terms of the grant.* Ethyl Gasoline Corp. v. United States, 309 U. S. 436, 456; United States v. Univis Lens Co., 316 U. S. 241, 251. *It is the public interest which is dominant in the patent system.*"



**The Woodfine patent should have been strictly construed because it was a minor improvement in a crowded art and also because it was a paper patent.**

We have already shown (*supra*, p. 3) that both courts below recognized that the terms of the patent claims did not cover petitioner's device. We have also stated (*supra*, pp. 7-8) some of the differences between the patented device and petitioner's device which make petitioner's device a fundamentally different and superior margin control mechanism. These facts alone should exclude any holding of infringement outside the terms of the claims, even giving the doctrine of equivalents its widest application.

As both courts below also recognized, the Woodfine patent was for a minor improvement in a very crowded art. It was not the first patent to show a fully operable remote margin control. The Olivetti patent (R. 187) and the Ramus patent (R. 177) are examples of prior remote margin control devices.

Aside from the specific mechanism for accomplishing remote margin control set forth in the claims and which petitioner does not use, the only thing of any substance which Woodfine added to the prior Ramus patent, for example, was a spring to move the margin stops toward one another when released. Certainly the mere use of a spring cannot rise to the dignity of patentable invention in this day and age, particularly in view of the many similar uses of springs in typewriter mechanism, as shown for example, in one of the Smith patents (R. 125) and the Champion patent (R. 135), which disclose the use of "Springs \* \* \* to bring the stops back to their last previous setting when they had been temporarily released to allow

writing in the previously used margin", as found by the District Court (R. 235).

The fact that the Woodfine patent has been used by no one, not even the respondent itself, also required that the patent be strictly construed. At the trial, counsel for respondent admitted that respondent's own margin control did not come within claims 1 and 2 of the patent, and petitioner adduced entirely uncontroverted evidence that respondent's margin control was not covered by claim 3 (R. 23, 45-6), or by claim 4 (R. 46), the only other claim contained in the patent. Although the District Court found that respondent "\* \* \* has not followed it [the patent] in all its details in its own construction \* \* \*" (R. 242), this lack of use of the patent by anyone was completely ignored by the Court of Appeals.

It has long been the law that a minor improvement patent, if it is to be held valid, must be strictly construed and limited as to the scope of its monopoly. This is particularly so where the patent is a so-called paper patent in that the construction shown and claimed has never gone into practical use. As stated in *Walker on Patents*, Deller's Edition, Vol. 3 (p. 1722):

"If a patent is not put into commercial use, it is not entitled to a construction of any broader scope than it is clearly required to be given."

The Court of Appeals in the present case not only failed to follow, but in effect overruled, its own 1915 decision in the case of *Underwood Typewriter Co. v. Royal Typewriter Co.*, 2 Cir., 224 Fed. 477 although that decision was urged upon the court. That case involved three patents for minor improvements added to the typewriter prior to 1915. The Court of Appeals pointed out (p. 477) that as of 1915 the



typewriter art had been developing for at least forty years, that in these circumstances typewriter improvement patents must be strictly construed and limited to the precise improvements claimed, and that "*There is no room for the doctrine of equivalents.*" By the time of the present case, as the District Court said, "Typewriters had been in use for some seventy years" (R. 241), yet both courts below gave a wide range of equivalents to the patent in suit in order to find infringement.

**The file of the Woodfine patent rules out any broad interpretation to find infringement outside the scope of the patent claims.**

The file wrapper of the Woodfine patent, Defendant's Exhibit 2 (R. 195-221), shows that when the application was filed it contained a broad claim 1 (R. 204-205) which would have read upon defendant's device, as well as prior devices. The application also contained the following statement:

"It is to be understood that the form of my invention herein shown and described is to be taken as a preferred example of the same, and that various changes as to the shape, size, and arrangement of parts may be resorted to without departing from the spirit of the invention or the scope of the subjoined claims" (R. 204).

After the Examiner had rejected the broad claim (R. 214), the patentee cancelled the claim without attempting to amend it, and accepted the narrow claims to specific mechanism here in issue. The patentee also cancelled from the specification the above quoted statement that various changes could be made without departing from the scope of the claims.

We submit that these actions of the patentee, disclosed in the file of his application, fully justified petitioner's reliance on the express limitations of the claims ultimately granted as excluding petitioner's remote margin control. The patentee should not be allowed, by the use of the doctrine of equivalents, a broader monopoly, which he impliedly disclaimed by his actions in the Patent Office.

### Conclusion

This case involves a question of far-reaching industrial and public importance which has been decided by the Circuit Court of Appeals contrary to the principles of law laid down by this Court to protect the public against unwarranted monopoly.

The decision below is incorrect and there is no likelihood that the courts of any other circuit will have an opportunity to consider the patent in suit. Unless that decision is reversed by this Court, respondent will levy heavy tribute on a very large and important part of the typewriter industry, will continue to hold the patent *in terrorem* over that industry, and to use the patent to block further development of the art.

It is earnestly urged that the petition be granted.

Respectfully submitted,

EDWIN T. BEAN,  
*Counsel for Petitioner.*

HENRY R. ASHTON,  
FRANCIS J. McNAMARA,  
CONRAD CRISTEL,  
*Of Counsel.*

August, 1948.

## APPENDIX

IN THE  
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1948

REMINGTON RAND INC.,  
*Petitioner,*

vs.

ROYAL TYPEWRITER COMPANY, INC.,  
*Respondent.*

No.

## Affidavit of Howard V. Widdoes

STATE OF NEW YORK }  
COUNTY OF NEW YORK } ss.:

HOWARD V. WIDDOES, being duly sworn, deposes and says:

1. That he is Vice-President of Remington Rand Inc., the petitioner in the above case, and is in charge of its Typewriter Division.

2. That as head of the Typewriter Division of Remington Rand Inc. one of his duties is to be generally familiar with the manufacture and sale of typewriters in the United States, both by Remington Rand and by its competitors.

3. That more than 95% of all typewriters manufactured in the United States are manufactured within the states of New York and Connecticut in the Second Judicial Circuit.

4. That the Woodstock Typewriter Company, the only typewriter manufacturer which does not have its principal place of business and typewriter factories within the Second Judicial Circuit, has a regular and established place of business in New York City, from which it sells and delivers typewriters, and has filed a certificate of doing business in the State of New York and qualified to do business there.

5. That approximately 66% of the standard typewriters now being manufactured in the United States (this excludes portable, noiseless and electric typewriters) include a remote margin control device. Such standard typewriters with remote margin control sold in 1947 had a retail sales value of more than \$70,000,000. All of such typewriters with remote margin control now on the market are made by the Royal Typewriter Company, the patent owner and respondent in this case, L. C. Smith & Corona Typewriters, Inc., the defendant in the companion case, and Remington Rand Inc., the defendant and petitioner in the present case. The margin control devices of L. C. Smith and Remington Rand have both been held by the same District Judge in Connecticut to infringe the Woodfine patent here in suit, despite admitted lack of correspondence with the terms of the patent claims. The Court of Appeals for the Second Circuit affirmed the decree of infringement against Remington Rand. L. C. Smith waived an appeal from the interlocutory judgment of infringement, pending an accounting and the decision on appeal in the present case. Accordingly, unless the decision below is reversed, all of the remote control margin setting devices now being manufactured are subjected to tribute to the Royal Company by reason of the Woodfine patent.

6. That in view of the concentration in the Second Judicial Circuit of the manufacture of more than 95% of the typewriters made in the United States and the further fact that the manufacturers of 100% of the typewriters made in the United States are subject to suit in the Second Judicial Circuit, which has in this case given the Woodfine patent such a broad construction, there is no likelihood of the courts of any other circuit having an opportunity to pass on either the validity or proper scope of the Woodfine patent.

HOWARD V. WIDDOES

Sworn to and subscribed before me  
this 29th day of July, 1948.

LYDA L. BARNER  
Notary Public.

LYDA L. BARNER  
Notary Public, State of N. Y.  
Residing in N. Y. County  
Clerk's No. 488, Reg. No. 81352  
Commission Expires March 30, 1950

[SEAL]



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FILED

SEP 23 1948

CHARLES ELMORE

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1948

REMINGTON-RAND INC.,  
*Petitioner,*

*vs.*

ROYAL TYPEWRITER COMPANY, INC.,  
*Respondent.*

No. 183

**PETITIONER'S REPLY TO RESPONDENT'S BRIEF  
IN OPPOSITION**

The brief for respondent in opposition to our petition for writ of certiorari largely avoids the issues upon which the petition is based and completely fails to negate the reasons relied upon for the allowance of the writ.

**The concentration of the typewriter industry in the second circuit makes it highly improbable that the Woodfine Patent will be litigated elsewhere and important that this Court should consider the monopoly granted to that patent by the decision of the court below.\***

As pointed out in our petition and brief and supporting affidavit, 95% of all typewriters manufactured in the United States are manufactured within the Second Judicial Circuit and all typewriter manufacturers are subject to suit in that circuit. These facts are not contested by respondent and,

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\*The opinion of the Circuit Court of Appeals has been reported at 168 F. 2d 691 since the petition was filed.

under the decisions cited in our brief, such concentration of industry in a single circuit has frequently led this Court to grant certiorari to review a decision sustaining a patent.

Respondent suggests (page 10 of its brief) that the reason which led this Court to grant certiorari in such cases has "lost much of its justification now with the adoption of the declaratory judgment act and the liberalization of the venue statutes effective September 1, 1948." As to this contention, it seems sufficient to point out that all of the cases cited in our brief on this point were cases in which certiorari was granted after the adoption of the declaratory judgment act in June, 1934. Whatever liberalization of the venue statutes may be provided in the new Judicial Code effective September 1, 1948, the important fact is that the patent owner here still has it within its power to confine litigation over the patent to suits which it can bring in the Second Circuit, where it can reach all existing competitors. As to declaratory judgment suits, respondent is a New York corporation (R. 3) and the record does not show that it is subject to suit in any other jurisdiction. Even if it is, it can still avoid a declaratory judgment suit merely by holding the patent as a silent threat to deter others from adopting remote margin control, without making any express allegation of infringement which would subject it to a suit for declaratory judgment.

Respondent's contention that the present decision "is only of importance to petitioner and respondent" (Respondent's Brief, p. 9) is somewhat naive. It is true that typewriter companies other than L. C. Smith & Corona, Royal and petitioner have not up to the present time adopted remote margin control for their typewriters. However, in view of respondent's contentions that the patent offers "a convenient accessory for typewriters" which is "a valuable



one" (Respondent's Brief, p. 9) and the finding that remote margin control "is an important talking point in the sales program" (F. F. 16, R. 246), it is clear that what is keeping such other manufacturers from adopting any kind of remote margin control is the threat of respondent's Woodfine patent. In view of the broad construction which the courts of the Second Circuit have now placed on this patent, these other manufacturers, subject to suit in that Circuit, are most unlikely to adopt any kind of remote margin control despite its desirability, unless this Court grants certiorari in the present case and corrects the improper decision below.

Although respondent attempts to belittle the importance of the decision below to the typewriter industry, it does not deny the accuracy of the Widdoes affidavit. That affidavit states that approximately 66% of the standard typewriters now being manufactured in the United States, with an annual retail sales value of more than \$70,000,000, include a remote margin control device. Respondent objects that these figures relate only to standard typewriters and expressly exclude portable, noiseless and electric typewriters. This objection is without any merit. The particular figures in the Widdoes affidavit were cited to show that the business involved is a large and important one. Respondent cannot deny this, because it admits *that standard typewriters are sold in greater quantities than all other types of typewriters together* (Respondent's Brief, p. 9).

**The use of the doctrine of equivalents to expand the patent monopoly beyond the terms of the claims is an anomaly and should be strictly limited.**

Respondent does not and cannot deny that petitioner's device is outside the express and unambiguous wording of

defendant does not always avoid infringement by combining two elements into one. In most of these cases, the claims literally read on the infringing device, one part of the device simply answering to two portions of the claim. This is not at all like the present case, where the claim expressly calls for a *pair* of oscillatory trip bars and only one is found in the device held to infringe.

Respondent does not even contend that Item 8 is found in defendant's device, but merely remarks that this item is not in the other two claims in suit. This, of course, in no way justifies the courts below in finding infringement of this claim when this element is completely missing from defendant's device.

The other element lacking in defendant's device is "*keys attached to each trip bar.*" As to this, respondent merely refers to the statement of the Court of Appeals that "it seems to us that we need not invoke the 'doctrine of equivalents' at all." Respondent does not attempt to justify this statement, which is simply a mistake by the court below. The keys of defendant's device are arranged so that a train of connecting members, running from the keyboard to the vicinity of the single trip bar, are moved and a projection on the end of the last member either raises or lowers the lip of the trip bar to release the detent on one or the other of the margin stops when one of the margin control keys is depressed. There is no contact or connection whatever, either direct or indirect, between the operating keys and the trip bar except when one of the keys is pressed down. Certainly the keys are not "attached" to the trip bar, as called for by the claim, any more than an automobile driver's right foot is attached to the brake pedal because on occasion the foot may be used to depress the pedal. As we pointed out in our petition, this difference is a most

important one and results from the difference between the keyboard margin control of petitioner and the carriage margin control of the Woodfine patent. Petitioner's device *could not operate at all* if the keys were actually attached to the trip bar as called for in the patent claims.

In view of the narrow margin between Woodfine and the prior art and the fact that no one has actually practiced the Woodfine patent, the holding below, using the doctrine of equivalents to expand the patent claims beyond their express scope, to include petitioner's different device, was manifest error.

**The file of the Woodfine patent rules out any broad interpretation to find infringement outside the scope of the patent claims.**

Respondent does not deny that the patentee, in order to obtain his patent in the Patent Office, cancelled a broad claim and accepted the specifically limited claims which are here involved, at the same time cancelling from the patent a statement that various changes could be made "without departing from the spirit of the invention or the scope of the subjoined claims." Respondent seeks to avoid the effect of these actions in the Patent Office by insisting that they are not sufficient to constitute a technical "file wrapper estoppel." Whether or not a true estoppel is involved, we do not think it is necessary to determine. The important fact is that these actions of the patentee were matters of public record in the Patent Office, which any member of the public would naturally consider in seeking to determine the proper scope of the patent, and they may also properly be considered by the Court as bearing on the right of the patentee to extend his monopoly outside the terms of the claims granted by the Patent Office.

As bearing on the intent of the patentee in accepting the limitations which are present in the claims, it is important to observe that he fully appreciated the possibility of using broad terminology in other elements of the same claims, as appears from elements 6 and 8 in Claim 2, each of which calls for "means" to perform certain functions. In using the specific language of limitation found in elements 7 and 9, the patentee must therefore have known and intended that these limitations would be given literal effect. The courts below were clearly in error in resorting to the doctrine of equivalents to avoid these specific limitations.

### Conclusion

The decision below is incorrect and there is no likelihood that the courts of any other circuit will have an opportunity to consider the patent in suit, because all typewriter manufacturers are subject to suit in the Second Circuit. The petition for writ of certiorari should be granted.

Respectfully submitted,

✓ EDWIN T. BEAN,  
*Counsel for Petitioner.*

✓ HENRY R. ASHTON,  
✓ FRANCIS J. McNAMARA,  
✓ CONRAD CHRISTEL,  
*Of Counsel.*

September, 1948

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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1948

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No. 183

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REMINGTON RAND, INC.,

Petitioner,

v.

ROYAL TYPEWRITER COMPANY, INC.,

Respondent.

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**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI**

This case does not present a situation justifying the grant of the petition. The concurrent decisions below finding infringement applied the law as established by many decisions of this court extending over a period of nearly a century to a situation coming clearly within its compass; no doubtful question of law is involved or even the application of the law to a borderline case. And the enforcement of the patent against this particular petitioner is not a matter of importance to the typewriter industry at large.

**The Decisions Below and the Question of Law Involved**

The patent in suit is for an improvement in margin regulators for typewriters. Claims 1 to 3 inclusive are in suit. While petitioner did not contest validity in either of the courts below, the district court examined the prior art and



found that the patented improvement "was a decided improvement in stop-setting mechanisms" (R. 235, f. 704) and "a substantial advance in the art" (R. 242, f. 724). On these and other findings, it held the patent valid (R. 247). The Court of Appeals, while accepting petitioner's concession of validity (R. 256), concurred with the district court in its appraisal of the value of the improvement. After noting that typewriters "on which a vast amount of ingenuity had been expended \* \* \* had for long offered a place for just such an improvement", the Court of Appeals said:

"Moreover, although the record amply proves that 'margin stops' themselves had received much attention and been the subject of a number of patents, nobody had ever before worked out their automatic return and that was a change which has proved of substantial service" (R. 258).

On the issue of infringement, the main defense was that petitioner's device does not correspond to the literal language of the claims in two respects (see italicized portions of items 7 and 9 of claim 2, petition, opposite p. 7. Similar provisions appear in claims 1 and 3.)\*

Only the first suggested non-correspondence is pertinent here, since in respect of the "second supposed departure" (item 9 of claim 2) the Court of Appeals did not find it necessary to "invoke the 'doctrine of equivalents' at all" (R. 259). The court found that infringement of this item of the claim "is well within any but a deliberately hostile interpretation of the claims" (R. 259). The second point relied on is, therefore, not pertinent to the petition, which rests on an alleged misapplication of the "doctrine of equivalents".

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\* Item 8 is also italicized but this provision only appears in claim 2. It was not considered by the Court of Appeals since it would not affect the decision as to claims 1 and 3. For the district court's discussion of this minor point, see R. 239-240.



The application of the doctrine of equivalents was made in connection with the provision in the claims for a pair of trip members or bars (item 7 of claim 2, for instance). The object of the Woodfine invention was to do away with the inconvenient manual setting of margin stops and to provide a device which would automatically move margin stops to the desired margin position. Woodfine accomplished this by "motorizing" the margin stops by means of a spring and providing tripping means operable by the operator from the front of the machine to release selectively the catch on the margin stops. The tripping means serve to release selectively the catch of the margin stop and hold the catch released while the margin stop, under the urging of the spring, automatically springs to the desired margin position. In his disclosure, Woodfine shows two trip bars for his tripping means and the claims specify a pair of trip members.

Petitioner substituted "a single bar with two tripping surfaces" for "the two trip bars shown by Woodfine" (R. 246, F. 19). This single bar with two trip surfaces was a known instrumentality for selectively releasing the catches on margin stops. It is shown in the Olivetti patent in a different combination (R. 189, particularly Fig. 8), as petitioner admitted below.

Both courts found that petitioner's single bar with two trip surfaces operates in substantially the same way to obtain substantially the same result and is the mechanical equivalent of the patent's two trip bars (District Court, R. 239; 242, f. 725; Court of Appeals, R. 258).

Applying the doctrine of equivalents, the Court of Appeals held that the character of Woodfine's contribution entitled him to protection "against so complete an appropriation as the defendant has made" (R. 258). The district court, in finding infringement, held that "confining him [Woodfine] to plural trip members would be a complete denial of the doctrine of equivalents" (R. 242).

The doctrine of equivalents is one of the oldest and most firmly established in the patent law. It lies at the heart of the patent system. It comes into play on questions of patentable novelty or invention (*Smith v. Nichols*, 21 Wall. 112, 119) as well as on questions of infringement. The doctrine stems from the sound legal principle that courts will give consideration to the substance of things and refuse to be bound rigidly by the mere name or form with which the parties may choose to clothe them. One of the classic statements of the rule is given by Justice Clifford in *Machine Co. v. Murphy*, 97 U. S. 120, 125.

As applied to questions of infringement, the rule cuts both ways. There may be no infringement even though there is verbal correspondence with the claims and, conversely, a mere colorable variation will be held an infringement even though literal correspondence may be avoided. *Bates v. Coe*, 98 U. S. 31, 42; *Westinghouse v. Boyden*, 170 U. S. 537, 568. Literal correspondence to the claims is not made the absolute test but consideration is also given as to whether there has been a substantial appropriation of the invention.

This court has repeatedly over the last hundred years applied the doctrine to hold as infringements mere colorable evasions of the claim.\* Any other rule would make piracy of inventions a habit.

As the doctrine is equitable in character, its limits cannot be precisely defined and doubtless it should in all cases be applied with caution. There is one situation, how-

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\* *Winans v. Denmead*, 15 How. 330, 342; *Seymour v. Osborne*, 11 Wall. 516, 560; *Ives v. Hamilton*, 92 U. S. 426, 431; *Imhaeuser v. Buerk*, 101 U. S. 647, 655-6, 662-4; *Clough v. Barker*, 106 U. S. 166, 176-7; *Hoyt v. Horne*, 145 U. S. 302, 308-9; *Potts v. Creager*, 155 U. S. 597, 600, 609; *Cash Reg. Co. v. Cash Indicator Co.*, 156 U. S. 502, 517; *U. S. v. Berdan etc. Co.*, 156 U. S. 552, 566; *Continental Paper Bag Co. v. Eastern etc. Co.*, 210 U. S. 405, 421; *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 42.

ever, which the courts have "with curious unanimity," as Judge Hand remarked below (R. 259), always held to come within the purview of the doctrine. That situation and the reasons for applying the doctrine to it are given by Judge Learned Hand in *Gibbs v. Triumph Trap Co.*, 26 F. 2d 312, 314:

"It is settled law, and it is good sense, that one does not escape infringement by combining into one element what a *claim specifies as two*, provided that the single element performs the function of both in the same way." (Emphasis ours.)

\* \* \*

"When a patentee prescribes two elements in a claim he means that each will contribute its share of the result, but their duality is not important. When the two are incorporated into a single physical element, it remains as much a means to the first result and a means to the second, as though it were in two parts. Were this not true, any ingenious mechanic might pick an inventor's brains at pleasure."

Like decisions are so numerous that the Court of Appeals below confined itself to citing its own (R. 259). Decisions of like tenor in other courts are listed below.\*

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\* *Seymour v. Osborne*, 11 Wall. 516, 560; *Clough v. Barker*, 106 U. S. 166, 177-8; and see companion case on defendant's improvement patent, 106 U. S. 178 at p. 180; *Mershon v. Sprague* (C. C. A. 1), 92 F. 2d 313, 317; *Courson v. Westinghouse etc. Co.* (C. C. A. 3), 263 Fed. 89, 94-5; *Kalamazoo etc. Co. v. Duff Mfg. Co.* (C. C. A. 6), 113 Fed. 264; *Nathan v. Howard* (C. C. A. 6), 143 Fed. 889, 893; *Bundy Mfg. Co. v. Detroit etc. Co.* (C. C. A. 6), 94 Fed. 524, 538; *Apex Electrical Mfg. Co. v. Maytag Co.* (C. C. A. 7), 122 F. 2d 182, 187; *Sears, Roebuck & Co. v. Delta Mfg. Co.* (C. C. A. 7), 78 F. 2d 745, 747; *Simplex Appliance Co. v. Star etc. Co.* (C. C. A. 7), 37 F. 2d 491, 492; *U. S. Ozone Co. v. U. S. Ozone Co. of Am.* (C. C. A. 7), 62 F. 2d 881, 889; *Hydraulic etc. Co. v. Williams etc. Co.* (C. C. A. 7), 165 F. 2d 489, 492; *N. Y. Scaffolding Co. v. Whitney* (C. C. A. 8), 224 Fed. 452, 463; *Pedersen v. Dundon* (C. C. A. 9), 220 Fed. 309, 311; *Bianchi v. Barili* (C. C. A. 9), 168 F. 2d 793, 801-2, 78 U. S. P. Q. 5, 11.

Thus, the present situation has long been recognized by repeated decisions as coming within the scope of the doctrine of equivalents. The application of the doctrine of equivalents here was not to a borderline case at all; it was not a "loose" or "uncertain" (Pet. 24, 25) but a chaste application of the doctrine. Failure to find infringement would, as the district court held, have been a "complete denial of the doctrine of equivalents". A more limited application of the doctrine can hardly be imagined. Indeed, its application here does little more than to interpret the terms of the claims realistically since it would be an interpretation not unreasonable and conforming to substance to hold that the two tripping surfaces of petitioner's single bar constitute, in fact, a pair of trip members, as specified by the claims.

There clearly has been no new, unusual or erroneous application of the doctrine of equivalents in this case.

**The Question of Law Posed by the Petition  
is Not Presented by the Present Case**

Although petitioner professes not to seek a review of the facts (Pet. 16), its statement of the case is at many points directly at variance with the concurrent findings of the lower courts. As a result a very different case is presented by the petition from that passed upon by the courts below.

First, petitioner repeatedly asserts that the patent is for a "minor" improvement in a crowded art (Pet., p. 16; see also pp. 4, 11, 24, 27; note however that at another point petitioner inconsistently refers to it as a dominating patent, Pet., p. 9). While both of the lower courts recognized that the patent was not of a pioneer character, they both held that the invention was a substantial advance in the art (see *ante*, p. 2).

Akin to this are petitioner's repeated averments that the patent is a mere paper patent (Pet., pp. 4, 10, 11, 16,

27, 28). But this is in conflict with the district court's finding (R. 245, F. 15). In the companion *Smith* case, the Judge said that the patent could not be "considered purely a 'paper' patent" (76 F. Supp. 190, at 193).

Petitioner also predicates its argument on the assertion that its device is fundamentally different and superior to the device of the Woodfine patent (Pet., pp. 7, 11, 13, 16, 27). But the district court found that petitioner's device "is substantially identical therewith in structure" (R. 246, F. 21) and the Court of Appeals characterized the slight differences in operation of the two devices as "inconsequential" (R. 258, ~~259~~ 259).

Akin to the the above assertion are petitioner's assertions that its device "departs substantially from the terms of the claims" (Pet., pp. 11, 13, 16). But the district court held the variations to be "immaterial" (R. 246, F. 21), and the Court of Appeals said the patent "is entitled to be protected against so complete an appropriation as the defendant has made" (R. 258).

It is upon the above assertions that petitioner bases its argument of unduly broad interpretation of the doctrine of equivalents and that it was loosely applied through the use of uncertain criteria (Pet., pp. 24-25). The argument is all beside the point, for the case posed is not the case decided below.

#### **No Question of File Wrapper Estoppel is Involved**

In its fourth point of argument (Pet., pp. 29-30), petitioner seeks to convey the impression that a question of file wrapper estoppel is involved. If such a question were really involved, it is certain that the experienced judges who decided the case below would not have ignored such an important point. The fact is that the contention is entirely without merit.

The application as filed contained five claims, the first of which was so broadly phrased as to cover the usual

*manual* margin regulator in standard use. It was rejected on the Buckingham patent which shows a specific form of the standard manual margin regulator. The claim was rightly rejected and was immediately cancelled. The remaining claims, with only minor amendments to present claims 2 and 4, were allowed as filed (R. 214-5).

Petitioner suggests that the rejection of this broad claim in some way restricts the remaining claims to their exact terminology. They do not explain why this should be so and do not cite any supporting authority. No file wrapper estoppel can arise here because *manual margin* regulators are not involved. Respondent does not seek to reach by the issued claims what was abandoned in original claim 1. That is as far as the file wrapper estoppel cases go.

Petitioner also refers to the cancellation of a conventional clause regarding permissible variations frequently included in specifications. This clause was "unnecessary since the law would secure him against imitation by other forms and proportions" (*U. S. v. Anciens Etablissements*, 224 U. S. 309, 328) and the voluntary cancellation of this clause, mere surplusage at best, has no significance. *Heap v. Greene* (C. C. A. 1), 91 Fed. 792, 794.\*

**The Enforcement of the Patent Against  
Petitioner is not a Matter of Importance  
to the Typewriter Industry at Large**

The legal questions passed upon in the case present no question of public importance for, as we have seen, the law is old and established and was correctly applied. Nor

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\* There is reason to believe that this clause was accidentally cancelled instead of the paragraph immediately preceding it (see R. 204), for this other paragraph, after the deletion of the immediately preceding matter, is left dangling. However, it is clear that the cancellation of the clause in question was not required by the Patent Office (see only Office action, R. 213-4).



is the enforcement of the patent against petitioner a matter of importance to the typewriter industry at large.

The patent clearly does not dominate the typewriter industry as petitioner suggests (Pet., p. 9). It relates to a convenient accessory for typewriters. It is a valuable one but it is not essential to typewriter operation. It has not been used at all by several companies, e.g. Underwood, I.B.M. and Woodstock, and is not used by petitioner itself on its portable and noiseless typewriters which comprise a substantial part of its typewriter business.

No additional infringers exist to be subject to or affected by the decision during the remaining life of the patent. Because of certain dealings between respondent and L. C. Smith & Corona Typewriter Company, the only other concern held to have infringed (see 76 F. Supp. 190), the district court granted L. C. Smith a license on reasonable royalty terms in the memorandum decision referred to in the petition (p. 6). Thus, the only concern which will be restrained by the decisions on the patent is petitioner.

The figures and percentages given in the Widdoe affidavit (Pet., p. 32) are irrelevant because they fail to show the percentage relating to petitioner's infringing business which is the only business to be restrained. In addition, we note that the percentage figures given are greatly inflated because they exclude portable, noiseless and electric typewriters which together are sold in nearly as great quantities as standard typewriters.

In view of the above facts, it is immaterial that typewriter manufacturers are either located in or amenable to suit in the Second Circuit since the decision is only of importance to petitioner and respondent. Such a private litigation has never been of interest to this court. The element of industry dominance by a patent, which was a factor in leading the court to grant certiorari in the cases cited by petitioner (Pet., p. 15), is lacking here.

We also suggest that the reason which led the court to grant certiorari in those cases affecting an entire industry where it appeared that all were amenable to suit in one circuit has lost much of its justification now with the adoption of the declaratory judgment act and the liberalization of the venue statutes effective September 1, 1948. The patent owner no longer has sole control over the choice of the forum. A wide choice is given a patent opponent and the possibility of a patent owner being able to restrict litigation to one circuit is remote indeed.

No questions of laches or estoppel are involved here. Petitioner does refer to its asserted reliance on opinion of counsel (Pet., pp. 6-7). But that opinion shows that counsel anticipated the possibility of patent litigation for the stated reason that petitioner's construction "is not too far removed from the Woodfine" patent (R. 228). Petitioner was promptly served with an infringement notice after it placed the infringing apparatus on the market and it was promptly sued after petitioner indicated its intention to pursue its course.

Respectfully,

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IN THE  
**Supreme Court of the United States**

October Term, 1948

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REMINGTON RAND INC.,

*Petitioner,*

vs.

ROYAL TYPEWRITER COMPANY, INC.,

*Respondent.*

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No. 183

**PETITION FOR REHEARING**

TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSO-  
CIATE JUSTICES OF THE SUPREME COURT OF THE  
UNITED STATES:

The basis of this petition for rehearing is that since the original petition was presented, this Court on October 11, 1948 has granted certiorari in *Graver Tank & Mfg. Co. Inc. et al. v. The Linde Air Products Co.*, Nos. 184-5, this term, in which the two principal reasons relied on for allowance of the writ are the same as the two reasons relied upon in the present case.

**I.**

The first reason relied upon for the allowance of the writ in the *Graver* case was that "the possibility of conflict between circuits is remote" (Petition, p. 17). As we showed in our original petition (pp. 8, 14), the possibility of conflict between circuits is even more remote in the present case, because every manufacturer of typewriters within the United States is subject to suit on the Woodfine patent in the Second Judicial Circuit.

## II.

The second reason advanced in the petition in the *Graver* case was that "important questions of patent law have been decided in a manner in conflict with the decisions of this Court" (Petition, p. 17). The second point of law advanced in support of this reason was as follows:

"(b) To expand unambiguous composition claims calling for alkaline earth metal silicates, the court below reached to the specifications. As this Court's cases since *White v. Dunbar* (1886), 119 U. S. 47, 51-2 and *McClain v. Ortmyer* (1891), 141 U. S. 419, 423-4 show, the claims measure the grant, and, while they may be limited, they may not be enlarged by the specifications." (Petition, P. 18.)

In the present case the Court below departed even further from the rule that the claims measure the patent grant and, instead of merely reaching to the specifications, went completely outside a patent for a minor improvement in a crowded art, not followed by the respondent in its own construction, and held infringement by a device not disclosed in the specifications and excluded by the express terms of the patent claims.\*

Thus, the second reason relied upon for the granting of the writ in both cases involves the very same point of law, namely, the misapplication of the doctrine of equivalents. In the present case, this has resulted in an unwarranted extension of the patent monopoly contrary to the public interest.

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\*The trial court found that "Admittedly the claims do not read literally upon the infringing device". (R. 236).

## III.

A close analogy to the present situation was presented in *Exhibit Supply Co. v. Acc Patents*, 315 U. S. 126, in which the Court originally denied a petition for certiorari and then granted certiorari on a petition for rehearing (314 U. S. 705), which pointed out common points of law between that case and *Muncie Gear Co. v. Outboard Co.*, 315 U. S. 759, in which certiorari had been granted on the same day (314 U. S. 594) that it had been originally denied in the *Exhibit* case (314 U. S. 637).

As pointed out in the petition for rehearing in the *Exhibit* case, where two cases thus present related questions of law, this Court has frequently heard and determined them together.\*

We respectfully suggest that the intervening circumstance of the granting of the writ in the *Graver* case requires that the Court shall not refuse to review the present case at this time unless satisfied of the soundness of the decision below expanding the monopoly of the Woodfine patent far beyond the express limitations of its claims, especially since it is highly improbable that a conflict between circuits will occur, and the two cases involve common points of law and may be conveniently considered together.

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\**Fashion Originators Guild v. Federal Trade Commission*, 312 U. S. 457, and *Millinery Creator's Guild v. Federal Trade Commission*, 312 U. S. 469; *Nelson v. Sears, Roebuck & Co.*, 312 U. S. 359, and *Nelson v. Montgomery Ward & Co.*, 312 U. S. 373; *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U. S. 159, and *General Talking Pictures Corp. v. Western Electric Company*, 304 U. S. 175; *Triplett et al. v. Lowell et al.*, 297 U. S. 638, and *Mantle Lamp Co. of America v. Aluminum Products Co.*, 297 U. S. 638; *Mercoird Corporation v. Mid-Continent Investment Co.*, 320 U. S. 661, and *Mercoird Corporation v. Minneapolis-Honeywell Regulator Co.*, 320 U. S. 680.

WHEREFORE, petitioner prays that this petition for rehearing of the petition for writ of certiorari be granted, that the cause be reviewed and that the judgment of the Court of Appeals for the Second Circuit be reversed.

Respectfully submitted,

EDWIN T. BEAN,  
*Counsel for Petitioner.*

HENRY R. ASHTON,  
FRANCIS J. McNAMARA,  
CONRAD CHRISTEL,  
*Of Counsel.*

October 25, 1948

#### **Certificate of Counsel**

I hereby certify that the foregoing petition is presented in good faith and not for delay, and that the petition is restricted to the grounds specified in Rule 33, subdivision 2, of the Rules of this Court.

EDWIN T. BEAN,  
*Counsel for Petitioner.*